

2



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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 WAGNER, MURABITO & HAO LLP
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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

24

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/431,002

Applicant(s)

PARTOVI ET AL.

Examiner

Marc D. Thompson

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 22.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's submission, Amendment C, received on 5/6/2004, has been entered into record.
2. Claims 1-25 remain pending.

Priority

3. This application is a continuation-in-part of co-pending parent application 09/426,102, filed 10/22/1999. Any claim in a continuation-in-part application which is directed solely to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application; *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *In re Von Lagenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972); and *Chromalloy American Corp. v. Alloy Surfaces Co., Inc.*, 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972).
4. The effective filing date for the subject matter defined in the pending claims which has support in parent 09/426,102 is 10/22/1999.

Drawings

5. The Examiner contends that the drawings submitted on 11/1/1999 are acceptable for examination proceedings.

Art Unit: 2144

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 10 recites "...to provided a second audio portion..." in Lines 5-6 of the claim. Use of the word "provided" in this context is idiomatic and it is unclear exactly what is being described.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Uppaluru (U.S. Patent Number 5,915,001), hereinafter referred to as Uppaluru.

11. Uppaluru disclosed network information servicing over an Internet utilizing standard telephony devices. See, inter alia, Column 3, Lines 36-48. The user dictated relevance and order of information presentation, thereby expressly providing implicit requests and responses

Art Unit: 2144

based on an inherently present “user profile”. See, inter alia, Column 3, Lines 49-60. The system further provided specific teachings dealing with HTML with audio for processing and retrieval. See, inter alia, Column 5, Lines 40-64. The use of packet switching networks and the delivery of audio information to telephones over these, PSTN, and arbitrary internets, directly provide “streaming” functionality. See, inter alia, Column 6, Lines 6-22. Voice recognition, standard telephone numeric input, menu system(s), and URL/URI to designate network resources were expressly disclosed. See, inter alia, Column 7, Lines 28-50. Information retrieval and presentation utilizing remote database(s) were expressly enabled. See, inter alia, Column 10, Lines 1-49. Further details of user personalization choices and customized presentation of information retrieved in the network were evident, inter alia, Column 11, Lines 10-62, Column 13, Lines 25-34, Column 14, Lines 20-37, and Column 18, Lines 45-54. The express use of user specific and selected default parameters used for implicitly requested content to a network telephone were further expressly provided in Column 19, Lines 7-60.

12. Thus, since all the limitations of the claimed invention as set forth in these claims were expressly provided by Uppaluru, claims 1-22 are rejected.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2144

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

15. Claims 1-9, 13-15, 17-18, and 21-25 are rejected under 35 U.S.C. §103(a) as being obvious over Krane (U.S. Patent Number 5,799,063), hereinafter referred to as Krane, in view of what would have been obvious to one of ordinary skill in the art at the time of invention.

16. Krane disclosed the use of a telephony device to generate/effect Internet access request(s). See, inter alia, Column 4, Lines 54-56. Thus, streaming information to a telephone using a networked computer was inherently present. User personalized data retrieval was evident, inter alia, in the combination of “Kathy Jones’ favorite web sites”, and express disclosure of request generation based on default (implicitly determined value(s). See, Column 5, Lines 34-42, and Column 7, Lines 31-37. Indeed, since each individual “favorite” web site would have been retrieved by the system based on previously executed user(s) behavior(s) which were not currently explicitly requested, these selection(s) were implicitly selected. Further, other automatic categorical choices based on user identification, behavior, or demographic profile, would have further constituted implicit requests. See, inter alia, Column 5, Lines 18-51. The audio information retrieved was transmitted and decoded at client terminal(s), hence “streamed”. See, inter alia, Column 4, Lines 40-45. The use of verbal and touch-tone menu and other requests, Internet specific resource access, audio formatting and conversion, URI/URL utilization for network remote information retrieval, standard PSTN network usage, minimal playback control, and multiple concurrent parallel streaming functions were evident in the

Art Unit: 2144

teachings. See, inter alia, Column 2, Line 9 through Column 3, Line 9, Column 4, Line 24 through Column 6, Line 58, and Column 7, Lines 1-8.

17. While Krane did not expressly use the term “implicitly chosen” in regard to streaming information received at the terminal unit(s), this feature was substantially disclosed as discussed above, and fails to constitute a patentable distinction in light of the state of the art at the time of invention. The provision for customizing content (of any type, including advertisements, menu options, greetings, etc.) based on the profile of a network user was notoriously well known to one of ordinary skill in the art at the time of invention. Since, minimally, Krane disclosed customized greeting(s) and menu(s) for user(s), implicitly chosen content was disclosed. The further provision for information processing to determine potential menu options or content delivery was likewise known to ordinary artisans, for example, using targeted advertisement(s). Demographic determination and targeted information delivery was widely implemented at the time of invention.

18. Claims 1-9, 13-15, 17-18, and 21-25 are rejected.

19. Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gershman et al. (U.S. Patent Number 6,199,099), hereinafter referred to as Gershman, in view of Mayer et al. (EP Patent Number 0 847 179 A2), hereinafter referred to as Mayer.

20. Gershman disclosed utilizing wireless phones and/or other thin client computing terminals to provide useful, customized/personalized information to end network users. See, inter alia, Column 2, Lines 56-67. The disclosure further described Internet based information

Art Unit: 2144

retrieval and user profile usage for enhanced usage of the system, including deductive reasoning for information provision to the user(s). See, inter alia, Column 29, Line 56 through Column 30, Line 46. The “egocentric” interface clearly dictated the use of “implicit” information requests, since a variety of correlated information not expressly asked for by the user was provided. See, inter alia, Column 30, Lines 30-45. Further, “personalization templates” were used for customized information retrieval and delivery. See, inter alia, Column 30, Line 64 through Column 31, Line 5, and Column 31, Lines 29-55. The disclosed conceptual idea of “intention” as set forth, inter alia, in Column 33, Lines 16-27, provided an end user with a myriad of implicit personalization options for any given occasion or circumstance. Also see, inter alia, Column 35, Lines 25-27. This functionality was coordinated by “intelligent agents” as set forth in, inter alia, Column 38, Line 33 through Column 39, Line 50. The inferred and argued (but not directly claimed) functionality of user history of action(s) was further disclosed in, inter alia, Column 40, Lines 1-4.

21. While Gershman disclosed the invention substantially as claimed, Gershman did not expressly disclose the retrieval of information in strictly an audio format as dictated by the claims and the arguments associated therewith. While Gershman did expressly disclose many of the claimed inventive limitations, including but not limited to the “user personalization choice(s)” as specified in the claims, Gershman failed to provide sufficient details for one of ordinary skill in the art to implement the invention on a purely wireless telephone device as directly suggested. See, inter alia, Column 2, Lines 56-67. An ordinary artisan would have been motivated to search the related arts for teachings which expressly provided for the requesting, retrieval, conversion(s) if necessary, and audio presentation of network retrieved information in

Art Unit: 2144

order to result in the usage of this system of Gershman with wireless telephony device(s) as directly set forth and suggested. Lastly, many of the Gershman figures and descriptions seem to rely upon pictorial representation (e.g., screen/monitor usage) to report information to a requesting user. Thus, it would have been motivating to one of ordinary skill in the art to isolate teachings which would have provided strictly audio interfacing with the networking system, since telephones without visual requirements were commonplace at the time of invention.

22. In the same arts of network information retrieval, Mayer expressly disclosed an audio browser. See, inter alia, Column 2. Mayer also specifically incorporated teachings which addressed enhancements using speech recognition, browsers without computer screens, network resource service linking, and data conversion resulting in streaming information, both expressly and fully by reference. See, Columns 2-4. Mayer fully disclosed, inter alia, touch tones, voice activated menus, audio streaming technology, PSTN, and general Internet (WWW) retrieval of information as known prior art, suitable for implementation within a system of this type. See, inter alia, Columns 1, 2, 9, 10, and 11. Mayer provided sufficient detail for one of ordinary skill in the art at the time of invention to provide the functionality expressly detailed by Gershman through the use of a network client terminal as simple as a telephone as provided by Mayer.

23. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network information retrieval system of Gershman with the network information retrieval system utilizing audio browser(s) provided by Mayer in order to provide full-fledged system operation as described by Gershman with typical network end user devices such as telephones (Gershman, Column 2, Lines 56-67, Mayer, Column 11, Lines 9-22).

24. Claims 1-25 are rejected.

Response to Arguments

25. The arguments presented by Applicant in the response, Amendment C, Paper #23, received on 5/6/2003, are not considered persuasive.

26. Applicant asserts that the prior art of record did not teach or fairly suggest implicit content requests and retrieval of associated content based on (previous) user behavior and action(s). See, Response, Paper #23, Amendment C, inter alia, Page 15. This limitation remains broad enough to include a myriad of functional components and methodologies, including but not limited to the dynamic assembly or insertion of *any information not expressly asked for* by the user, partly or entirely based on a user selected profile entry. This methodology was notoriously well known and widely implemented at this broad definitive level in the art at the time of invention. Consider, for instance, a “default” value(s) having been specified, based on the particular user input. It is also noted that the features upon which applicant relies (i.e., details present in the specification, actions based on user behavior and actions, and minimally, any details of the processing of user profile(s), etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

27. Since all the applied art either directly disclosed delivery of information not expressly requested, and/or provided customized delivery of both content and menu options to the end user, the provision for implicitly selecting information for delivery to the client end user cannot be considered novel and unobvious. It is suggested Applicant continue to modify the claimed invention to distinguish over the prior art of record by providing details of how this functionality is performed, as opposed to a general allegation that it is possible in conjunction with the

remaining system limitations. Applicant is always welcome to contact the Examiner to advance prosecution and guide the application closer to allowance.

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 703-308-6750. The examiner can normally be reached on Monday-Friday, 9am-4pm. Note: The Examiner expects to move to the new PTO site in Carlyle in the next few months, and contact information will change at that time. If not available at the above number, The Examiner can be reached at 571-272-3932.

Art Unit: 2144

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON
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PRIMARY EXAMINER

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Art Unit 2144